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Supreme Court, U.S.
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No. 97-

IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1997

DAVID DEES, D/B/A DAVID DEES ILLUSTRATION,

Petitioner,

v.

SABAN ENTERTAINMENT, INC.,

Respondent.

Petition for a Writ of Certiorari to the
United States Court of Appeals
for the Ninth Circuit

PETITION FOR A WRIT OF CERTIORARI

MICHAEL R. BLAHA
2530 Wilshire Blvd., Third Floor
Santa Monica, CA 90403
(310) 828-4847
Counsel for Petitioner

35 PP

Lorraine Mitchell Legal Briefs

732 E. WASHINGTON BOULEVARD
LOS ANGELES, CALIFORNIA 90021-3088
(213) 747-5631 • FAX: (213) 747-5843

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QUESTIONS PRESENTED

1. Under 17 U.S.C. § 204(a), may a copyright transferee escape the requirement that the transfer be in writing by having the author of the subject work confirm in writing a previous oral transfer agreement, as the Ninth Circuit has held in this case and previously, or should invocation of this judicially created exception to § 204(a) - the "subsequent ratification rule" - be limited to actions involving third party infringers, as the Second, Sixth, Seventh and Eleventh Circuits have held?

2. Does a writing transferring copyright ownership which fails to specifically identify the work being transferred satisfy the certainty requirements of § 204(a), as the Ninth Circuit has held here, or does § 204(a) mandate that the work be specifically mentioned in any such writing, as suggested by the decisions of the Second, Sixth, Seventh and Eighth Circuits?

PARTIES TO THE PROCEEDINGS

David Dees d/b/a David Dees Illustration was plaintiff-appellant below and is the petitioner in this Court.

Saban Entertainment, Inc. was the defendant-appellee below and is the respondent in this Court.

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Petition for a Writ of Certiorari to the
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PETITION FOR A WRIT OF CERTIORARI

David Dees d/b/a/ David Dees Illustration petitions for a writ of certiorari to review the judgment of the Court of Appeals for the Ninth Circuit in this case.

OPINIONS BELOW

The Opinion of the Court of Appeals was not published and is included in the appendix hereto ("App.") at 1a. The Order of the District Court granting Saban summary judgment is included at App. 5a.

JURISDICTION

The Ninth Circuit's judgment below was filed on December 3, 1997. This Court has jurisdiction under 28 U.S.C. § 1254.

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

Section 204(a) of Title 17, U.S.C. provides:

"A transfer of copyright, other than by operation of law, is not valid unless an instrument of conveyance, or a note or memorandum of the transfer, is in writing and signed by the owner of the rights conveyed or such owner's duly authorized agent."

INTRODUCTION

This Petition asks the Court to resolve the conflict among the circuits on two questions of interpretation of 17 U.S.C. § 204(a), the "copyright statute of frauds:" (i) in a dispute with the author of the subject copyright, may a transferee escape the writing requirement of § 204(a) by having the author later confirm in writing a previous oral transfer agreement and (ii) does a writing transferring copyright ownership which fails to specifically identify the work being transferred satisfy

the specificity requirements of § 204(a)? Of the five Circuits which have considered the first question, only the Ninth Circuit, the Court of Appeals in this case, has applied the subsequent ratification rule when the underlying infringement action is between an author and his initial transferee; the rest of the Circuits have held, at least implicitly, that subsequent ratification should not be permitted in that instance. With respect to the second question, the Ninth Circuit once again appears to be at odds with the other Circuits who have reviewed this issue. This Court should take this opportunity to conclusively define the requirements of 17 U.S.C. § 204(a) and thereby assure uniform interpretation throughout the United States of this critical provision of the Copyright Act.

STATEMENT OF THE CASE

Petitioner David Dees ("Dees") is a freelance designer and illustrator. In November, 1992, Respondent Saban Entertainment, Inc. ("Saban") engaged Dees, on an independent contractor basis, to design and illustrate a logo for Saban's Mighty Morphin Power Rangers property (the "Logo"). Dees designed and illustrated the Logo in November, 1992.

Four months later, on March 16, 1993, Dees and Saban both executed Saban's form "WORK-FOR-HIRE/INDEPENDENT CONTRACTOR AGREEMENT" (the "Form Agreement"). Dees received a check in the amount of $250.00 from Saban on that same date.

Saban has stated that the Form Agreement confirmed the parties' prior agreement regarding the

creation of the Logo. (*See* R. 94, lines 6-7; Respondent-Appellee's Opening Brief at 29).

Pursuant to the terms of the Form Agreement, Dees acknowledged that he "had rendered/and or will render services" to Saban " on "one or more projects" and agreed that his services, the results and proceeds thereof and all material "were and/or will be created" as a "'work-made-for-hire.'" The Form Agreement collectively defines all such material, services and results and proceeds as "Material." The Form Agreement also states that if any of the Material is determined to not be work-made-for-hire (hereinafter the less cumbersome "work-for-hire" will be used), then all of the specified rights in the Material shall be "deemed transferred and assigned to" Saban pursuant thereto.

The words "Mighty Morphin Power Rangers" do not appear anywhere on the Form Agreement. The word "logo" likewise is absent. In fact, there is no reference whatsoever in the Form Agreement to the Logo, the work Dees had authored and was supposedly transferring forever to Saban,

The Logo was first published in Episode #1 of the Mighty Morphin Power Rangers television show, on or about August 26, 1993. Saban obtained copyright registration PA 620 838 for that episode, effective September 15, 1993.

On October 6, 1995, Dees filed a Complaint in the United States District Court for the Central District of California against Saban, alleging causes of action for copyright infringement and related, pendent state claims. On April 8, 1996, Saban answered and counterclaimed.

Saban filed a Motion for Summary Judgment on May 13, 1996, on the grounds relevant here that, pursuant to the terms of the Form Agreement, the Logo was either a work for hire or that Dees had transferred his copyright in the Logo to Saban. On May 20, 1996, Dees opposed Saban's motion, arguing that because the Form Agreement wasn't signed until several months after the Logo was created, the Logo was not a work-for-hire, and that since the Form Agreement did not satisfy the requirements of 17 U.S.C. § 204(a), it did not effect a transfer of Dees' copyright in the Logo to Saban.

On June 3, 1996 the District Court granted Saban's motion, agreeing that the Logo was a work for hire and that Dees had, in any event, transferred whatever rights he had in the Logo to Saban by the Form Agreement. Appendix (App.) 2a. The Ninth Circuit Court of Appeals, by a vote of two to one, affirmed the District Court in a Memorandum Opinion on December 3, 1997, holding that the Form Agreement transferred Dees' copyright in the logo with the requisite specificity, citing *Effects Associates, Inc. v. Cohen*, 908 F.2d 555 (9th Cir. 1990), *cert. denied sub nom. Danforth v. Cohen,* 498 U.S. 1103 (1991). In a dissenting opinion, the Eighth Circuit judge, sitting by designation, found that the Form Agreement did not satisfy the requirements of 17 U.S.C. § 204(a) and voted to reverse and remand.

REASONS FOR GRANTING THE WRIT

Dees created the Logo without a written agreement and then, at Saban's request, signed the Form Agreement, which purported to retroactively transfer Dees' copyrights to Saban in unspecified "Material." Affirming the District Court's grant of summary judgment, the Ninth Circuit approved of the application

of the "subsequent ratification" exception to 17 U.S.C. 204(a) against Dees, the plaintiff author, in favor of Saban, the defendant transferee and held that the Form Agreement was sufficient under § 204, even though the Form Agreement did not specifically transfer the Logo.

In doing so, the Ninth Circuit reiterated its willingness to extend the subsequent ratification exception further than the Second, Sixth, Seventh and Eighth Circuits, who have repeatedly limited its application to cases where a third party infringer was attempting to invoke § 204(a) against a plaintiff transferee. In addition, there is no doubt that the Second, Sixth, Seventh and Eighth Circuits would reject the Ninth Circuit's view that the Form Agreement was sufficient to transfer Dees' copyright in the Logo to Saban, notwithstanding the fact that the Form Agreement failed to specifically identify the work (the Logo). In order to avoid conflicting decisions among the Court of Appeals on the same set of facts, this Court should grant Certiorari to guarantee uniform application of the statute of frauds provision of the Copyright Act, 17 U.S.C. § 204(a).

I. THE COURT SHOULD RESOLVE THE CONFLICT AMONG THE CIRCUITS REGARDING THE INTERPRETATION OF 17 U.S.C. § 204(a)

Section 204(a) of the Copyright Act of 1976 provides, in relevant part, that a "transfer of copyright . . . is not valid unless an instrument of conveyance, or a note or memorandum is in writing." This section has been universally acknowledged as the Copyright Act's "statute of frauds." *See, Imperial Residential Design, Inc. v. Palms Development Group, Inc.*, 70 F.3d 96, 99 (11th

Cir. 1995); *Schiller & Schmidt, Inc. v. Nordisco Corp.*, 969 F.2d 410, 413 (7th Cir. 1992); *Effects Associates, Inc. v. Cohen*, 908 F.2d 555, 557 (9th Cir. 1990), *cert. denied sub nom. Danforth v. Cohen*, 498 U.S. 1103 (1991); *Eden Toys, Inc. v. Florelee Undergarment Co., Inc.*, 697 F.2d 27, 36 (2nd Cir. 1982); *Great Southern Homes, Inc. v. Johnson & Thompson Realtors*, 797 F.Supp. 611 (M.D. Tenn. 1992).

A. The Conflict Concerning Subsequent Ratification

The Second Circuit, in *Eden Toys, Inc. v. Florelee Undergarment Co., Inc.*, was the first Circuit to carve out an exception of this new statute of frauds provision in the 1976 Act.[1] The *Eden Toys* court held that, since the purpose of § 204(a) was to "protect copyright holders from persons . . fraudulently claiming oral licenses," that section's requirement of a writing could be satisfied by the copyright owner's later execution of a writing which confirms the [oral] agreement." *Eden Toys, Inc.*, 697 F.2d at 36. However, the Second Circuit limited its holding to the facts before it:

> "In this case, in which the copyright holder appears to have no dispute with its licensee on this matter, it would be anomalous to permit a

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[1] An earlier case in the Second Circuit, *Khan v. Leo Feist*, 165 F.2d 188 (2d Cir. 1947), was decided under the 1909 Act and is therefore omitted from this analysis.

third party infringer to invoke this provision against the licensee." *Id.* at 36.[2]

In *Wales Industrial, Inc. v. Hasbro Bradley, Inc.*, 612 F.Supp. 510 (S.D.N.Y. 1985), the Southern District of New York cited *Eden Toys* when it held that § 204(a)'s writing requirement is satisfied by the copyright owner's subsequent execution of a writing confirming a prior oral transfer "at least where, as here, there is no evidence of any dispute between the owner and licensee as to the validity of the alleged oral grant." *Wales Industrial, Inc.*, 612 F.Supp. at 516. There is little doubt that this is still the rule in the Second Circuit.[3]

The Eleventh Circuit adopted *Eden Toys'* restrictive application of the subsequent writing exception to § 204(a). *Arthur Rutenberg Homes, Inc. v. Drew Homes, Inc.*, 29 F. 3d 1529 (11th Cir. 1994). In fact, the Eleventh Circuit opinion in *Drew Homes,* not only quoted from *Eden Toys*, but it added emphasis to that part of the *Eden Toys* opinion which limited application of the rule to cases where the copyright holder had no dispute with its licensee. *Drew Homes*, 29

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[2] By limiting the application of this exception to § 204(a) to cases involving third party infringers, the Second Circuit was acting in accord with its earlier ruling in *Gilliam v. American Broadcasting Companies, Inc.*, 538 F.2d 14, 21, n.5, (2d Cir. 1976), which indicated that ratification, by a holder of a derivative work to claim copyright ownership could only be used against a third party infringer.

[3] *See, e.g., Intimo, Inc. v. Briefly Stated, Inc.*, 948 F.Supp. 315, 318 (S.D.N.Y. 1996).

F.3d at 1532. One year later, the Eleventh Circuit reiterated its adherence to *Eden Toys*' limited employment of the subsequent writing exception. In *Imperial Residential Design, Inc. v. Palms Development Group, Inc.*, 70 F.3d 96 (11th Cir. 1995), the Eleventh Circuit held that a third party infringer could not invoke § 204(a) to challenge an owner's subsequent written confirmation of a prior oral transfer, and once again limited use of this exception to cases "where there is no dispute between the copyright owner and the transferee about the status of the copyright." *Imperial Residential Design*, 70 F.3d at 99.

District courts in the Sixth and Seventh Circuits have cited *Eden Toys* with approval, and, like the Second Circuit, have also painstakingly limited the subsequent writing exception to cases involving third party infringers. In *Great Southern Homes, Inc. v. Johnson & Thompson Realtors*, 797 F.Supp. 609 (M.D. Tenn. 1992), the court, sitting in the Sixth Circuit, adopted the limitations of *Eden Toys*, holding that "the Statute of Frauds provision was not intended to benefit a third party infringer." *Id.* at 611.[4] In the Seventh Circuit, the district court in *Balsamo/Olson Group, Inc. v. Bradley Place Limited Partnership*, 966 F.Supp. 757 (C.D. Ill. 1996), cited with approval the Eleventh Circuit's decision in *Drew Homes*, and once again

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[4] Ironically, the district court in *Great Southern* distinguished *Effects Associates, Inc. v. Cohen*, 908 F.2d 555 (9th Cir. 1990), *cert. denied sub nom. Danforth v. Cohen*, 498 U.S. 1103 (1991) on the grounds that it did not involve a suit by a third party infringer.

limited the exception permitting later memorialization of a prior oral transfer to cases "where there is no dispute between the copyright owner and the transferee about the status of copyright." *Id.* at 763.

There is no doubt that if petitioner had signed the Form Agreement anywhere but the Ninth Circuit, his Complaint for copyright infringement against Saban would be proceeding. In this case, there most definitely was a dispute between the copyright owner [petitioner] and Saban [the transferee] regarding the status of the copyright, and the Second, Sixth, Seventh and Eleventh Circuits would have uniformly rejected Saban's attempt to invoke the parties' subsequent writing (the Form Agreement) to avoid the requirements of § 204(a).

On the other hand, the Ninth Circuit decision below permitted just that, and is therefore in conflict with the rule expressed in those other Circuits - a written confirmation of a prior oral transfer will only satisfy § 204(a) in cases involving third party infringers. Admittedly, the paucity of detail in the opinion of the Ninth Circuit below might cause the Court to question whether the rule in the Ninth Circuit is actually at odds with the rest of the country. It most definitely is.

The first case in the Ninth Circuit to cite *Eden Toys* appears to be *Valente-Kritzer Video v. Pinckney*, 881 F.2d 772, 775 (9th Cir. 1989). *Pinckney* did not limit the reach of the subsequent writing exception to actions involving third party infringers; in fact, unlike all of the cases cited above, the Ninth Circuit's opinion in *Pinckney* does not include any language - from *Eden*

Toys or any of the other cases - restricting the use of the exception to actions involving third party infringers.[5]

The Ninth Circuit next considered this question in *Konigsberg Intl. Inc. v. Rice*, 16 F.3d 355 (9th Cir. 1994). In a surprising shift from *Pinckney*, the court in *Konigsberg* (while again neglecting to note that the subsequent writing rule had always been limited to cases involving third party infringers) held that "the writing in question must, at the very least, be executed more or less contemporaneously with the agreement." *Konigsberg*, 16 F.3d at 357. Indeed, the court suggested that it might go further than *Eden Toys,* and find that any writing that purported to confirm a prior oral transfer which "substantially predates the writing" was invalid under § 204(a). *Id.*, n.3.

Unfortunately, the Ninth Circuit significantly retreated from *Konigsberg* in *Magnuson v. Video Yesteryear*, 85 F.3d 1424 (9th Cir. 1996). While the court finally acknowledged the language in *Eden Toys* limiting the application of the subsequent writing exception to cases involving third party infringers, *Magnuson*, 85 F.3d at 1428-29, the court went on to hold that *Magnuson* was just such a case. Although it did not appear necessary, the court went on to distinguish *Konigsberg*'s affirmative holding that the subsequent writing exception couldn't be used by a transferee

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[5] The *Pinckney* court held that the writing there - a letter from the attorney for the defendant author which expressly reserved his client's comments - communicated a clear intent not to be bound thereby. There is no question that if the subject writing was adequate, the Court would have permitted the transferee to use it to establish copyright transfer and ownership.

against an author: "Thus, the problem with the writing in that case [*Konigsberg*] was not. . . that it was not contemporaneous with the [prior oral] agreement . . ." *Magnuson*, 85 F.3d at 1429, n. 1, However, the dissent in *Magnuson* urged the court to follow *Konigsberg*, and hold, in conflict with *Eden Toys*, that later writings could *not* relate back to prior oral grants.[6] 85 F.3d at 1433 (Fernandez, J., dissenting).

Finally, the Northern District of California in *Graham Technology Solutions, Inc. v. Thinking Pictures, Inc.*, 949 F.Supp. 1427, 1432 (N.D. Cal. 1997), permitted a subsequent writing to confirm a previous oral transfer, even though the dispute was between the author and the transferee, in conflict with *Konigsberg* and *Eden Toys* and the line of cases following it. Perhaps because it realized that it could not square its decision with *Konigsberg*, the court in *Graham Technology* chose to effectively limit its evaluation of *Konigsberg* to that case's finding that the parties there had not negotiated the prior oral transfer in question. Since the parties in *Graham Technology* had extensive negotiations before entering into the later written confirmation, the court there distinguished *Konigsberg* on that basis.

A conflict exists between and within the Ninth Circuit, and the Second, Sixth, Seventh and Eleventh Circuits regarding this critical issue: can the statute of frauds be ignored in a case of copyright infringement between the transferee and the author? Petitioner urges the Court to grant this petition to resolve this recurring

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[6] This internal conflict within the Ninth Circuit was noted in 3 Melville B. Nimmer and David Nimmer, *Nimmer on Copyright* § 10.03[A][3] at 10-39 (1997).

conflict. *Community for Creative Non-Violence v. Reid*, 490 U.S. 730 (1988).

B. The Conflict Concerning Specificity of the Work

Section 204(a) requires a written transfer of copyright, but the statute itself sets no parameters for what information must be included in such writing. Several Circuits have addressed this question, with varying results.

Most relevant to the case at bar is the Ninth Circuit's holding in *Effects Associates, Inc. v. Cohen*, 908 F.2d 555 (9th Cir. 1990), *cert. denied sub nom. Danforth v. Cohen*, 498 U.S. 1103 (1991), upon which the Court of Appeals below relied.

In *Effects*, the Court set a dangerously low threshold for what § 204(a) requires:

> "The rule is really quite simple: If the copyright holder agrees to transfer ownership to another party, that party must get the copyright holder to sign a piece of paper saying so. It doesn't have to be the Magna Charta; a one-line pro forma statement will do."

Id. at 557. This holding is particularly surprising because it was made after the court, citing *Community for Creative Non-Violence v. Reid*, 490 U.S. 730 (1988), determined that:

> "Section 204 ensures that the creator of a work *will not give away his copyright inadvertently* and forces a party who wants to use the copyrighted

> work to negotiate with the creator *to determine precisely what rights are transferred* and at what price . . . Most importantly, section 204 enhances predictability and certainty of copyright ownership - 'Congress' paramount goal' when it revised the Act in 1976. *Community for Creative Non-Violence*, 109 S.Ct. at 2177; *see also Dumas v. Gommerman*, 865 F.3d 1093, 1103-04 (9th Cir. 1989). Rather than look to the courts every time they disagree as to whether a particular use of the work violates their mutual understanding, parties need only look to the writing that sets out their respective rights" *(emphasis supplied). Id.* at 557.

The "one line pro forma statement" minimum § 204(a) requirement espoused by the court in *Effects* hardly "enhances predictability and certainty of copyright ownership" and, as applied here, resulted in the petitioner, in fact, "giv[ing] away his copyright inadvertently." The dissenting opinion below points this out succinctly:

> "In this case the evidence suggests that Plaintiff did not intend to transfer his copyright. The disputed agreement [the Form Agreement], at best, represents *an inadvertent transfer* . . ." *(emphasis supplied).*

Dissenting Opinion, App. 3a. The dissent goes on to hold that the "one-line pro forma statement" dictated by *Effects* is not enough: "there must first still be evidence of an agreement." *Id. See also, Papa's-June Music, Inc. v. McLean*, 921 F.Supp. 1154, 1159 S.D.N.Y. 1996) ("the terms of any writing purporting to transfer

copyright interests, even a one-line pro forma statement, must be clear.")[7]. The minimal "one-line pro forma statement" requirement in the Ninth Circuit has not been followed by the other Circuits. In *Playboy Enterprises, Inc. v. Dumas*, 53 F.3d 549 (2nd Cir. 1995), *cert. denied* 116 S.Ct. 567 (1995), the Second Circuit was confronted with the specificity requirements of § 204(a), and did not cite *Effects*.[8] The district court had determined that one type of endorsement legend on the back of checks cashed by the author-defendant's predecessor in interest

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[7] The first district court sitting in the Ninth Circuit which published an opinion citing *Effects* declined to adopt the "one-line pro forma statement" threshold and, in fact, rejected a writing because it did not identify the "subject matter" of the copyright transfer. *Pamfiloff v. Giant Records, Inc.*, 794 F.Supp. 933, 936 (N.D. Cal. 1992). The same district later distinguished Pamfiloff on its facts (the written copyright assignment there "did not contain [an] essential term"), by noting that in the case then before it, the writing did specifically identify the copyrights in the multimedia project ("rock.com") being transferred. *Graham Technology Solutions, Inc. v. Thinking Pictures, Inc.*, 949 F.Supp. 1427, 1432 n. 7 (N.D. Cal. 1997).

[8] *Playboy* also addressed the later writing exception in the context of a work for hire agreement, holding that the parties must agree before the creation of the work, citing *Schiller & Schmidt*, 969 F.2d 410, but differing with *Schiller* by finding that the "actual writing memorializing the agreement" need not be executed before creation. This conflict between the Second and Seventh Circuits on the application of the subsequent writing exception to § 204(a) in work for hire cases is "fairly included within" the first question presented.

was insufficient to meet the writing requirement. The Second Circuit affirmed, noting that while the legend in question purported to transfer the author's "'right, title and interest in and to the following items: [a description of a painting followed],'" the legend did not mention the word "copyright" and the district court correctly found that the legend was not indicative of an understanding between the parties.

An additional conflict exists between the Second Circuit and the Seventh Circuit on the degree of specificity needed in a § 204(a) written transfer, specifically, whether the word "copyright" must appear in a § 204(a) writing. *See, Schiller & Schmidt, Inc. v. Nordisco Corp.*, 969 F.2d 410, 413 (7th Cir. 1992) (an agreement for "all assets" need not contain the word "copyright") This conflict was highlighted in *Papa's-June Music, Inc. v. McLean*, 921 F.Supp. 1154, 1159 (S.D.N.Y. 1996), where the court followed the Seventh Circuit's rule in *Schiller*, acknowledging but then disregarding the rule in its own Circuit as set forth in *Playboy*.

The Eighth Circuit is also in conflict with *Schiller*. In *Saxon v. Blann*, 968 F.2d 676 (8th Cir. 1992), the court held that the omission of the word "copyright" from the written transfer agreement (which purported to transfer "ownership rights" in a specified book) was fatal to the defendant's claim of ownership pursuant to § 204(a). *Saxon* at 678: "To transfer ownership of a copyright, the parties must state in writing that they intend to transfer a copyright."

Petitioner urges this Court to adopt a uniform rule of interpretation of § 204(a), one that requires, at a minimum, that the writing in question specifically

identify the work being transferred.[9] In all of the Circuits but the Ninth, there is no doubt that this requirement has already been imposed on § 204(a), at least implicitly. Because there is further conflict in the Second and Seventh Circuits as to what a writing under that section must contain, this issue is ripe for intervention and resolution by this Court.

II. THIS CASE PRESENTS AN EXCELLENT OPPORTUNITY TO ADDRESS RECURRING QUESTIONS ABOUT THE INTERPRETATION OF § 204(a)

Even if this Court determines that no conflict exists between the Circuits, the Ninth Circuit's opinion herein decides important questions of federal law that should be, but have not yet been, resolved by this Court. This Court has certainly expressed a willingness in the past to grant certiorari when important questions involving interpretation of the Copyright Act are presented. *See, e.g., De Sylva v. Ballentine*, 351 U.S. 570 (1956); *Public Affairs Associates, Inc. v. Rickover*, 369 U.S. 111 (1962).

In addition, as evidenced by the survey herein of the courts which have examined these two issues of § 204(a) interpretation, the questions presented are important and recurring, and thus are appropriate for

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[9] By doing so, the Court would be bringing § 204(a) into practical alignment with § 205(c), which requires that a document must specifically identify the work it pertains to before recordation of it will be deemed to give constructive notice.

consideration by this Court. *Glus v. Brooklyn Eastern District Terminal*, 359 U.S. 231 (1959).

Dees authored a copyrighted work, the Logo, for Saban in November, 1992. Four months later, apparently having realized that it neglected to reach an agreement with Dees back in November, Saban proffered the Form Agreement, which did not mention the Logo in any fashion. This is the exact situation § 204(a) was enacted to avoid. *See, Imperial Residential Design, Inc. v. Palms Development Group, Inc.*, 70 F.3d 96, 99 (11th Cir. 1995); *Schiller & Schmidt, Inc. v. Nordisco Corp.*, 969 F.2d 410, 413 (7th Cir. 1992); *Effects Associates, Inc. v. Cohen*, 908 F.2d 555, 557 (9th Cir. 1990), *cert. denied sub nom. Danforth v. Cohen*, 498 U.S. 1103 (1991); *Eden Toys, Inc. v. Florelee Undergarment Co., Inc.*, 697 F.2d 27, 36 (2nd Cir. 1982).

The issues presented by this petition go to the very heart of the writing requirement of 17 U.S.C. § 204(a). If this Court accepts either question for consideration and finds the Form Agreement lacking because it was signed subsequent to the parties' purported oral transfer agreement, or because it does not specify the work being transferred, petitioner will be permitted his day in court.

CONCLUSION

For the foregoing reasons, the petition for certiorari should be granted.

MICHAEL R. BLAHA
2530 Wilshire Blvd., Third Floor
Santa Monica, CA 90403
(310) 828-4847
Counsel for Petitioner

FILED
DEC 3 1997
CATHY A. CATTERSON, CLERK
U.S. COURT OF APPEALS

Not for Publication

UNITED STATES COURT OF APPEALS

FOR THE NINTH CIRCUIT

DAVID DEES, d/b/a
DAVID DEES ILLUSTRATION,

Plaintiff-Appellant,

v.

SABAN ENTERTAINMENT, INC.,

Defendant-Appellee.

No. 96-56029
D.C. No. CV-95-06740-R

MEMORANDUM*

Appeal from the United States District Court
for the Central District of California
Manuel L. Real, Chief Judge, Presiding

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* This disposition is not appropriate for publication and may not be cited to or by the courts of this circuit except as provided by 9th Cir. R. 36-3.

Argued and Submitted November 6, 1997
Pasadena, California

Before: **GIBSON**[**], **KOZINSKI AND TROTT,** Circuit Judges.

The disputed agreement transferred plaintiff's copyright in the Mighty Morphin Power Rangers' logo with as much specificity as the law requires. See Effects Assocs., Inc. v. Cohen, 908 F.2d 555, 557 (9th Cir. 1990). No admissible evidence contradicted the agreement's representation that there was consideration. The state law claims relied on the copyright claims. Plaintiff does not contest the award of attorney's fees unless we reverse the substantive judgment. We don't. However, we award no attorney's fees on appeal. 17 U.S.C. Sec. 505.

AFFIRMED.

[**] The Honorable Floyd R. Gibson, United States Court of Appeals for the Eighth Circuit, sitting by designation.

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U.S. COURT OF APPEALS

FLOYD R. GIBSON, Circuit Judge, dissenting.

I respectfully dissent from the Court's decision which affirms that the disputed agreement effectively transferred Plaintiff's copyright in the Mighty Morphin Power Rangers' logo. This Court, in Effects Associates, Inc. v. Cohen, 908 F.2d 555, 557 (9th Cir. 1990), held that section 204's purpose was to "ensure[] that the creator of a work will not give away his copyright inadvertently and [to] force[] a party who wants to use the copyrighted work to negotiate with the creator to determine precisely what rights are being transferred and at what price."

In this case, the evidence suggests that Plaintiff did not intend to transfer his copyright. The disputed agreement, at best, represents an inadvertent transfer as the terms of the transfer were disguised within a "Work for Hire/Independent Contractor Agreement." Section 204(a) requires an intentional as opposed to an inadvertent agreement to transfer.

Plaintiff's original agreement with Defendant stated that Plaintiff's logo was to be used by Defendant only on a video cover and sell sheets and that Plaintiff would be entitled to compensation for additional uses of the logo. However, Defendant, represented by legal counsel with expertise in copyright law, appears to have purposely taken advantage of Plaintiff, a layperson

unrepresented by legal counsel at the time of signing, with its proposed "Work-for-Hire/Independent Contractor Agreement." This agreement and the circumstances surrounding its signing do not reflect a true negotiation where the parties determined "precisely what rights are being transferred and at what price." Id.

Moreover, this purported transfer is also independently invalid because it was not supported by any new consideration. The evidence shows that the $250.00 paid on March 16, 1993 was for payment for Plaintiff's revisions to the logo.

Although a written "one-line pro forma statement" is all that section 204(a) minimally requires to transfer copyright ownership, there must first still be evidence of an agreement. Id. For these reasons, I would reverse and remand for trial.

LODGED
MAY 13 1996
CLERK, U.S. DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA
WESTERN DIVISION

FILED
JUN 3 1996
CLERK, U.S. DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

ENTERED
U.S. DISTRICT COURT
JUN 5 1996
CENTRAL DISTRICT OF CALIFORNIA
DEPUTY

ANTHONY M. KEATS (State Bar No. 123672)
LARRY W. MCFARLAND (State Bar No. 129668)
DAVID K. CAPLAN (State Bar No. 181174)
BAKER & HOSTETLER
600 Wilshire Boulevard
Los Angeles, California 90017
(213) 624-2400

Attorneys for Defendant and Counterclaim Plaintiff, SABAN ENTERTAINMENT, INC.

UNITED STATES DISTRICT COURT

CENTRAL DISTRICT OF CALIFORNIA

DAVID DEES d/b/a/
DAVID DEES ILLUSTRATION,

Plaintiff,

v.

SABAN ENTERTAINMENT,

Defendants.

Civil Action No.: 95-6740-R

JUDGMENT

Date: June 3, 1996
Time. 10:00 A.M.
Place: Ctrm. of the
Hon. Manuel L. Real

SABAN ENTERTAINMENT, INC.,

Counterclaim Plaintiff,

v.

DAVID DEES d/b/a/ DAVID DEES ILLUSTRATION,

Counterclaim Defendant.

THIS CONSTITUTES NOTICE OF ENTRY AS REQUIRED BY FRCP, RULE 77(d)

Defendant and Counterclaim Plaintiff Saban Entertainment, Inc.'s Motion for Summary Judgment ("Saban's Motion") was heard by the Court on June 3, 1996. Plaintiff and Counterclaim Defendant David Dees d/b/a/ David Dees Illustration ("Dees") appeared by counsel Keith Rouse; Defendant and Counterclaim

Plaintiff Saban Entertainment, Inc., ("Saban") appeared by counsel Larry McFarland of Baker & Hostetler.

On consideration of all the evidence set forth in the papers submitted and the oral arguments, Saban's Motion is granted on the Court's finding (1) that Dees' work performed for Saban on the Mighty Morphin Power Rangers logo was work-made-for-hire under 17 U.S.C. Sec. 101; (2) to the extent any of the work was not work-made-for-hire, any rights Dees had in the Mighty Morphin Power Rangers logo were assigned and transferred to Saban; (3) Dees is not the owner of the copyright in the Mighty Morphin Power Rangers logo and may not bring a claim for copyright infringement against Saban; (4) Dees' state claim for unfair competition fails because Dees has no basis for asserting a likelihood of confusion; (5) Dees' Dees' state claim for dilution fails because Dees has no protectable rights in the logo which he alleges was diluted; (6) Dees' claim for breach of contract fails because of the existence of the later written March 16 agreement and because it is barred by the statute of limitations.

IT IS ORDERED that Saban's Motion is GRANTED on the merits.

IT IS FURTHER ORDERED that Dees' federal copyright certificate of registration #VA 733-814 for the Mighty Morphin Power Rangers Logo be cancelled.

IT IS FURTHER ORDERED that Saban is the prevailing party, and that Saban is awarded its attorneys' fees and costs pursuant to the Copyright Act, 17 U.S.C. Sec. 505. The amount of such fees and costs to be

determined in accordance with the Local Rules of this Court.

DATED; June 3, 1996

/s/ REAL
United States District Judge

Presented By:
ANTHONY M. KEATS
LARRY W. MCFARLAND
DAVID K. CAPLAN
BAKER & HOSTETLER

By: /s/ Larry W. McFarland
LARRY W. MCFARLAND

Attorneys for Defendant and
Counterclaim Plaintiff,
SABAN ENTERTAINMENT, INC.